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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,902	08/10/2005	Kevin Jeffrey Barnham	18583	7111
272 7590 01/02/2009 SCULLY, SCOTT, MURPHY & PRESSER, P.C. 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER SEAMAN, D MARGARET M				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
01/02/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/521,902

**Applicant(s)**

BARNHAM ET AL.

**Examiner**

D. Margaret Seaman

**Art Unit**

1625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-36, 38 and 40 is/are allowed.
- 6) ☒ Claim(s) 37, 39 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
- Paper No(s)/Mail Date 12/19/08.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This application was filed 8/10/2005 and is a 371 of PCT/AU03/00914 (7/16/2003) which claims priority to AU 2002950217 (7/16/2002). Claims 30-35 and new claims 36-41 are before the Examiner.

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 37, 39 and 41 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while maybe enabling for making salts of the claimed compounds, does not reasonably provide enablement for making solvates of the claimed compounds. The specification does not enable any person skilled in the art of synthetic organic chemistry to make the invention commensurate in scope with these claims. "The factors to be considered [in making an enablement rejection] have been summarized as a) the quantity of experimentation necessary, b) the amount of guidance or direction presented, c) the presence or absence of working examples, d) the nature of the invention, e) the state of the prior art, f) the relative skill of those in that art, g) the predictability or unpredictability of the art, h) and the breadth of the claims", *In re Rainer*, 146 USPQ 218 (1965); *In re Colianni*, 195 USPQ 150, *Ex parte Formal*, 230 USPQ 546. In the present case, the important factors leading to a conclusion of undue experimentation are c) the absence of any working example of a formed solvate, the lack of

predictability in the art, and the broad scope of the claims. There are no working examples of any solvate formed. The claims are drawn to solvates, yet the numerous examples presented all fail to produce a single solvate. These cannot be simply willed into existence. As was stated in *Morton International Inc. v. Cardinal Chemical Co*, 28 USPQ2d 1190 “The specification purports to teach, with over fifty examples, the preparation of the claimed compounds with the required connectivity. However...there is no evidence that such compounds exist...the examples of the ‘881 patent do not produce the postulated compounds...there is ... no evidence that such compounds even exist.” The same circumstances appear to be true here. There is no evidence that solvates of the instantly claimed compounds actually exist; if they did, they would have been formed. Hence, applicants must show that solvates can be made, or limit the claims accordingly. G) The state of the art is that it is not predictable whether solvates will form or what their composition will be. In the language of the physical chemist, a solvate of an organic molecule is an interstitial solid solution. This phrase is defined in the second paragraph on page 358 of West (Solid State Chemistry). West, Anthony R., “Solid State Chemistry and its Application, Wiley, New York, 1988, pages 358 & 365. The solvent molecule is a species introduced into the crystal and not part of the organic host molecule is left out or replaced. In the first paragraph on page 365, West says, “it is not usually possible to predict whether solid solution will form, or if they do form, what is their compositional extent”. Thus, in the absence of experimentation, one cannot predict if a particular solvent will solvate any particular crystal. One cannot predict the stoichiometry of the formed solvate, i.e. if one, two or a half of a molecule of solvent added per molecule of host. In the same paragraph on page 365, West explains that it is possible to make meta-stable non-equilibrium solvates, further clouding what

Applicants mean by the word solvate. Compared with polymorphs, there is an additional degree of freedom to solvates, which means a different solvent or even the moisture of the air that might change the stable region of the solvate. H) The breadth of the claims includes all of the hundreds of thousands of compounds of formula (I) as well as the presently unknown list of solvents embraced by the term "solvate. Thus, the scope is broad.

3. applicant has argued in the response dated 10/10/2008 that the declarations presented show enablement of hydrates and solvates. Hydrates have been shown but solvates have not been shown in the declarations presented or in the instant specification. Due to this, the claims drawn to solvates remain rejected.

#### *Allowable Subject Matter*

4. Claims 30-36, 38 and 40 are free of art. The rejections of claims under 102 and 103 as stated in paper dated 4/18/2008, are withdrawn due to applicant's amendments around the 102 art and affidavits showing unexpected results over the 103 of record.

#### *Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Margaret Seaman whose telephone number is 571-272-0694. The examiner can normally be reached on 730am-4pm, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Margaret Seaman/  
Primary Examiner, Art Unit 1625